

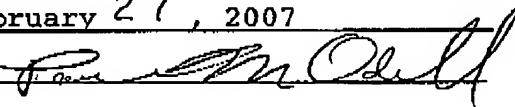

FEB 27 2007

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) SEA00820P01271US	
I hereby certify that this correspondence is being transmitted via facsimile No. 571-273-8300 to the U.S. Patent and Trademark Office on <u>February 27, 2007</u> Signature <u></u> Typed or printed name <u>Paul M. Odell</u>		Application Number 10/796,352	Filed 03/09/2004
		First Named Inventor Bruce M. Mueller et al.	
		Art Unit 1732	Examiner Leo B. Tentoni
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/>	applicant/inventor.	Signature	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Typed or printed name Paul M. Odell	
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number 28,332	Telephone number (312) 876-1800	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	Date February 27, 2007	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/>	Total of <u>1</u> forms are submitted.		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

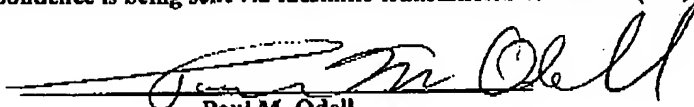
FEB 27 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Bruce M. Mueller et al.)	<u>PATENT APPLICATION</u>
)	SEA0820P1271US (SC-148 Div.)
Serial No.:	10/796,352)	
)	Group Art Unit: 1732
Filed:	March 9, 2004)	
)	Confirmation No. 1983
For:	COMPRESSION MOLDING)	
	PROCESS AND ARTICLE)	
	MADE BY THE PROCESS)	
)	
Examiner:	Leo B. Tentoni)	

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being sent via facsimile transmission to fax No. (571) 273-8300, on February 27, 2007.



Paul M. Odell

Mail Stop AF
Commissioner For Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This paper is filed in response to the FINAL Action dated November 7, 2006 and before the filing of an Appeal Brief in connection with the above-identified application. The period for reply expires on March 7, 2007. Therefore, this response is timely filed.

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below.

REMARKS

Reconsideration of the application, and allowance of all claims pending are respectfully requested. Applicants respectfully request that a panel of experienced examiners, including at least a supervisor and the Examiner of Record, formally review in detail the legal and factual basis of the rejections in the application prior to the filing of an Appeal Brief. It is believed there

Serial No. 10/796,352 - - - 2

is clear deficiency in the prima facie case in support of the rejections of record, and that they clearly are not proper and are without basis.

The Examiner has not made any prior art rejections of the claims.

Claims 1-12 remain pending. Of the twelve pending claims, only claims 1 and 7 are independent claims.

The 35 U.S.C. §112, First Paragraph, Rejection

In Item 2 of the Official Action, the Examiner has rejected all of the claims under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner refers to step D in independent claims 1 and 7, and the Examiner alleges that the claims set forth "subject matter which is not described in the specification to enable one skilled in the art to which it pertains...." The applicants believe that the Examiner is wrong.

With respect to step D of independent claims 1 and 7, the Examiner has stated that (1) the specification does not teach "how a small end of a billet is adjacent, and extends over a portion of, a first mold part third surface region," and (2) the specification does not teach "how a large end of a billet is adjacent, and extends over a portion of, a first mold part first surface region."

The Examiner is wrong for two, independently sufficient, reasons:

(1) The patent drawings show the claimed arrangement (e.g., FIG. 11 clearly shows the claimed arrangement); and

(2) The specification describes the claimed arrangement (e.g., lines 1 and 2 of page 20, explicitly state that the "smaller end is adjacent the first mold part lid region mold surface 93 [which is further defined in alternate terms at page 18, line 10, as the "third surface region 93"]...."; and lines 26-27 of page 19 explicitly set forth the "larger end of the billet projecting into the closure body region of the first mold part 90" [which is further defined in alternative terms, at page 18, lines 2-3, as having a "first surface region 91"]....").

The language quoted above from the specification on pages 18, 19, and 20 corresponds substantially identically with the language used in the independent claims 1 and 7. Contrary to

Serial No. 10/796,352 - - - - 3

the Examiner's assertion, this provides a clear teaching to one of ordinary skill in the art how the billet ends are positioned.

Further, the specification clearly teaches that the billet can be positioned as claimed either manually by hand or with a pick and place device 80 (e.g., see the specification page 17 (lines 19-22 and 29-30), and page 21 (lines 28-30). No undue experimentation is required.

The 35 U.S.C. §112, Second Paragraph, Rejection

In Item 4 of the Official Action, the Examiner has rejected all of the claims under 35 U.S.C. §112, second paragraph, as being indefinite.

The Examiner alleges that the claims are "indefinite principally because it is not clear how an end (large or small) of the billet can be adjacent and extend over a portion of a region" of the first mold part, and because "it is not clear exactly how far (e.g., a distance) each end (large or small) extends over a portion of a region" of the first mold part.

FIGS. 11 and 12 show a billet 60 having a small end adjacent, and extending over a portion of, the first mold part third surface region 93 and having a large end adjacent, and extending over a portion of, the first surface region 91. For a particular configuration of an article to be molded from the billet 60, the amount that each end of the billet 60 projects into the adjacent surface region depends on the width of the second surface region 92 between the surface regions 91 and 93 (e.g., the width of the hinge area 26 in FIG. 1 compared to the lid 24 in FIG. 1 and body 22 in FIG. 1) and depends upon the size of each end of the billet.

A person of ordinary skill in the molding art would understand that the amount of thermoplastic molding material in the billet 60 for molding the article must be simply equivalent to the amount of material in the finished, molded article. One of ordinary skill in the art considers the volume of the molded article, and then calculates the amount of material needed to fill the three parts of the mold cavity. That is, for an article 20 defined by a mold cavity having a first portion (e.g., closure body 20 (in FIG. 3)), a second portion (e.g., a closure hinge 26), and a third portion (e.g., a closure lid 24), the volumes of those portions of the molded article are determined, and then the billet 60 is made so that (1) the volume of the large end corresponds to the volume of the article first portion (e.g., closure body 22), (2) the volume of the central portion

Serial No. 10/796,352 - - - 4

of the billet corresponds to the volume of the article second portion (e.g., hinge 26), and (3) the volume of the billet small end corresponds to the volume of the article third portion (e.g., lid 24). The billet 60 is positioned so that (1) the billet large end is adjacent the first mold part first surface region 91 defining the first side article first portion (e.g., body 22), (2) the billet central portion is adjacent the first mold part second surface region (92) defining a first side of the article second portion (e.g., hinge 26), and (3) the billet small end is adjacent the first mold part third surface region defining the first side of the article third portion (e.g., closure lid 24).

One of ordinary skill in the molding art would understand that (1) the billet large end can have any suitable shape, but the large end volume must correspond to the volume of the completed molded article first portion (e.g., closure body), (2) the billet central portion can have any suitable shape, but that the volume of the central portion must correspond to the volume of the article second portion, (e.g., closure hinge), and (3) the billet small end can have any suitable shape, but the small end must correspond to the volume of the article third portion (e.g., lid 24).

The distance that the large end or small end of the billet extends over its adjacent region thus depends upon the selected shape (i.e., configuration) of the billet end. However, for whatever shape is selected by one of ordinary skill in the art, one of ordinary skill in the art would understand that an end of the billet extending beyond the second region 92 (e.g., extending beyond the hinge region) should have a volume that corresponds to the volume of the portion of the article that is to be molded by that end of the billet. Thus, one of ordinary skill in the molding art would appreciate that a "longer" billet for molding a given article would extend further over the first and third surface regions than a "shorter" billet having the same volume. The amount of the extension of each end of the billet beyond the second (middle) region depends on the configurations which have been selected to provide the plastic material volumes corresponding to the respective portions of the completed article.

Clearly, no undue experimentation is required.

Serial No. 10/796,352 - - - - 5

Withdrawal of the rejections of all of the claims under 35 U.S.C. §112 is respectfully requested.

Respectfully submitted,

By: 

Paul M. Odell, Reg. No. 28,332

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
Citicorp Center, Suite 3800
500 West Madison Street
Chicago, Illinois 60661-2511
(312) 876-1800